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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,626	07/27/1999	FELIX MOK	PM-262743	5745

7590

11/19/2002

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INTELLECTUAL PROPERTY GROUP
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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 11/19/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/361,626

Applicant(s)

Mok et al.

Examiner

Ivars Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 29, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, and 10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 10 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy. As pointed out previously, Nagy discloses a process for removing trace amounts of aluminum from a sodium chloride brine wherein the brine is treated with magnesium chloride to produce a magnesium concentration of 5-25 ppm therein (col. 5, line 12), and wherein sodium hydroxide is added to this brine to provide an excess alkalinity concentration of 0.15 g/l, thereby forming a magnesium aluminum hydroxide precipitate. Accordingly, this reference discloses the claimed invention with the exception of the recited magnesium to aluminum molar ratio. However, the exact magnesium to aluminum molar ratio in the reference process is not seen to materially affect the overall results of this process, or to produce any new and unexpected result; and is therefore deemed to be an obvious matter of choice, which is insufficient to patentably distinguish the claims.

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Applicant's arguments filed August 29, 2002 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues, primarily, that the Twardowski declaration submitted May 1, 2002 demonstrates new and unobvious results for the claimed invention, and therefore should overcome the 35 U.S.C. 103(a) rejection based on Nagy. It is pointed out, however, that this declaration fails to demonstrate new and unexpected results over the closest prior art, and is therefore not deemed to be persuasive of patentability. The closest comparison to the Nagy process appears to be Experiment #1, run #3, on page 8 of the above noted declaration. This run apparently adds a magnesium salt in an amount to provide a magnesium concentration of 5 ppm (covered by claims 1-7, 9 and 10; and disclosed by Nagy at line 12 of col. 5), and also adds an alkali metal hydroxide (i.e. NaOH) to provide an excess alkalinity of 0.1-0.2 g/l (covered by claims 1-7, 9 and 10; and disclosed by Nagy at lines 47-48 of col. 3). The Mg to Al ratio in this run was determined to be 11.1 (covered by claims 1, 3-7, 9 and 10; and unknown in the Nagy process). However, since the Twardowski declaration fails to present any other test runs with different Mg/Al ratios at the same Mg concentration and excess alkalinity, this declaration does not demonstrate any new and unobvious results for the recited Mg to Al ratio over the closest

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prior art (i.e. Nagy). Applicant should note that the process of Nagy will inherently produce a brine having some magnesium to aluminum molar ratio, and absent a showing that the recited range produces a new and unexpected result, the exact magnesium to aluminum molar ratio employed by Nagy remains an obvious matter of choice, insufficient to patentably distinguish the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can

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normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached at (703) 308-1972.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Ivars C. Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
November 17, 2002